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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,025	09/01/2000	Mark L. Yoseloff	PA0463.ap.US	5837

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/654,025	YOSELOFF ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11 and 15-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11 and 15-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

♦

This action is Final responsive to the amendment filed 4-12-2005.

Claims 11 and 15-26 are pending.

♦

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim **24** rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for revealing wild symbols one at a time, does not reasonably provide enablement for the sequential causing of each symbol to have a wild function . The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Specifically the cited portions of the applicant's specification do not provide support for the individual or sequential consideration of wild symbols. The portions of the specification cited by applicant do provide for a sequential revealing of the wild symbols and the treatment of a reel location as a wild symbol after it's identification however, there is a disconnect between the revealing of a symbol as a wild symbol and the sequential treatment of a wild symbol as a wild symbol for the determination of an award. As set forth in Claim 23

from which claim 24 is noted as dependent, steps (d) and (e) the Applicant's claimed invention provides a determination of winning conditions present and the providing of prizes associated with said winning combinations further modified by the limitations of claim 24 without specifying at which point the modification is inserted. Hence if a symbol was "sequentially" transformed prior to steps (d) and (e) this would provided for the multiple consideration of prize amounts not presented enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim **24** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically claim **24** provides for the sequential association of symbols with a wild function without setting forth at which point the winning combinations are determined or awarded to the player as set forth in the associated independent claim **23**. For the purposes of examination the process of claim **24** has been interpreted as being fully incorporated into step (c) of the preceding independent claim **23**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **11**, **15-25,** and **26** are rejected under 35 U.S.C. 102(e) as being anticipated by O'Halloran (US 6,439,993).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With regards to claim **11**, O'Halloran teaches a method an apparatus for a video wagering game including:

a player placing a wager on a reel-slot-type video game event having a plurality of symbol positions(Abstract & Col 1:5-19);

displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position (Abstract, Col 1:5-19, & Figure 1);

upon the occurrence of a predetermined triggering event (Figure 2 Elm 30), randomly selecting

between zero and fewer than a maximum number of viewable symbol positions (Fig 3 Elm 31) as a wild symbol position (Col 2:60-67);

converting (substituting) each symbol displayed within each selected wild symbol position to a wild symbol (Col 1:53-54; Fig 3 Elm 31) wherein the wild symbol operates on at least one but not all of the displayed game symbols (Fig 2,3,4,7; Col 2:48-54; Col 2:60-3:8); and

determining game outcomes based on the displayed game symbols and wild symbols (Col 3:17-30).

With regards to claims **15**, and in addition to the above stated, O'Halloran teaches "wild card symbols provides the player with an additional opportunity to win a prize, or to win an additional prize" (Col 3:1-3) which is held to encompass a "bonus feature" as claimed.

Claim limitations directed to the addressing of winning events (bonus outcomes) and in particular the resolving of winning events, is met by O'Halloran as the basic/traditional operation of a game of chance (Col 1:5-19).

Claim limitations directed to the occurrence of a "predetermined triggering event for a bonus event, randomly selecting at least one and fewer than all of said plurality of

symbol positions as a wild symbol position" is met by the display of a trigger wild card symbol and the subsequent display of at least one further wild card symbol on a win line as taught by O'Halloran (Col 2:60-67) but not on lines not played or utilized by the player (Fig 2-4, & Col 1:48-54).

Claim limitations directed to the converting symbol displayed within a wild symbol position (equivalently line) to a wild symbol is met by the substitution of symbols as taught by O'Halloran (Col 2:60-67).

With regards to claims **16-18**, and in addition to the above stated, O'Halloran teaches the resolution of winning events before the operation of any wild symbols and after (about the same time) as the operation of any wild symbols (Col 3:18-30). It is additionally noted that the "operation of any of the wild symbols" is presently interpreted as the treatment of additional wild symbols (Elm 31) originating from the first occurrence of the first wild symbol (Elm 30) while the first wild symbol (Elm 30) would be encompassed in "a plurality of randomly selected game symbols on the display" as so presented.

With regards to claim **19**, and in addition to the above stated, O'Halloran teaches the inclusion of 15 viewable positions (Figure 1).

With regards to claim **20**, O'Halloran teaches the transformation of the wild symbol before the game outcome is determined (Col 2:64-67).

With regards to claims **21-23,** and **25-26**, O'Halloran teaches that of *N* total symbols in a given win line only *N-1* may be wild symbols (Col 3:38-44 & Claims 18, 22,

25). The claimed wild function being operable to increase the likelihood of meeting at least one of the winning conditions is provided for by O'Halloran in the addition of wild cards that serve in "providing the player with an additional opportunity to win a prize" (Abstract). The claimed limitations directed to "visually distinguishing" locations the wild function" is provided for O'halloran as an exemplary "@" (Col 2:60-3:9).

Claim **24** is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US 6,439,993) in view of applicants admitted prior art.

O'Halloran is silent regarding the sequential treatment of each of the symbols displayed at each one of the designated locations as wild symbols however the sequential unveiling of a game out come is old and well known for drawing out the user's anticipation during game play. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the sequential unveiling of a game out come in the previously presented combination of O'Halloran and applicant's admitted prior art in order to draw out the player's anticipation of a game result.

Response to Arguments

Applicant's arguments filed April 12th, 2005 have been fully considered but they are not persuasive.

Claim rejections under USC 112 have been amended above in view of the applicant's arguments and amendments.

The rejection of claims **11** and **19-21** has been clarified above with regards to the Applicant's proposed points of novelty. O'Halloran teaches the conversion of each designated wild symbol (Fig 2), wherein each wild symbol acts on the symbols of a specific win line but not the remainder of symbols presented on separate lines (Fig 2).

The rejection of claims **15-18**, and **22** has been clarified above with regards to the Applicant's proposed points of novelty. O'Halloran teaches each wild symbol acts on the symbols of a specific win line but not the remainder of symbols presented on separate lines (Fig 2).

The rejection of claims **23-26** has been clarified above with regards to the Applicant's proposed points of novelty. O'Halloran teaches each wild symbol acts on the symbols of a specific win line but not the remainder of symbols presented on separate lines (Fig 2) which is operable to increase the likelihood of meeting at least one of the winning conditions (Abstract).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM

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SUPERVISORY PATENT EXAMINER
TC3700